

## REMARKS/ARGUMENTS

Claims 1-20 are pending in the present application and remain in this application for prosecution. None of the claims has been amended.

The office action states that claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0157981 to Marks *et al.* ("Marks") in view of U.S. Patent No. 6,050,895 to Luciano *et al.* ("Luciano"). However, claims 1 and 10 (which are the only independent claims) have been rejected only over Marks. Similarly, dependent claims 2, 3, 9, 11, 14, 17, 18, and 20 have also been rejected only over Marks. Only dependent claims 4-8, 12, 13, 15, 16, and 19 have been rejected over Marks in view of Luciano.

### **I Rejections Over Marks**

The Applicant respectfully suggests that the claim rejections cannot stand because they fail to consider the entire teaching of Marks, which makes it clear that Marks' wagering game is specifically designed to be devoid of pay lines and, hence, teaches away from any combination that would include pay lines. As discussed in more detail below, this flaw is enough to overcome the final rejection of the pending claims.

#### **A. Marks' Wagering Game Lacks "Pre-Defined Player-Selectable Pay Lines" -- Marks Only Mentions "Pay Lines" When Describing the Prior Art That His Wagering Game Was Designed to Overcome**

Marks discloses a wagering game that is specifically designed to be different from a traditional slot machine in that it avoids the use of pay lines. Marks mentions the term "pay

lines” in the Background Section while describing what has been done in the prior art slot machines.

For each winning outcome, which may be predetermined symbol combinations along any enabled pay line for the machine or a set of predetermined scattered symbols, the processor issues an award to the player.

Marks, Para. 4 (emphasis added). After describing the prior art, Marks then describes how the winning outcomes will be determined in Marks’ wagering game -- based on adjacent symbol set arrangement as they appear anywhere in the array, not along any enabled pre-defined pay line.

It is an object of the present invention to provide a new game in the form of a game matrix where awards are based upon and issued for obtaining predetermined winning outcomes of symbol sets, arranged for example in adjacent same symbol sets such as horizontally, vertically, diagonally or in an L-shaped arrangement.

Marks, Para. 9 (emphasis added). Thus, Marks’ wagering game calls for awards to be made if the same symbols make some type of adjacent symbol set arrangement, not if the symbols are aligned along pre-defined pay lines. It is noteworthy that a full text search of Marks reveals that the term “pay line” is only used once in Marks --- in Marks’ Background Section when describing prior art slot machines with “enabled pay lines.” Without question, the adjacent-same-symbol-set arrangements of Marks’ wagering game are not pre-defined pay lines and, not surprisingly, Marks never refers to them as pay lines.

## **B. MARKS TEACHES AWAY FROM THE USE OF “PAY LINES”**

Not only does Marks fail to teach the use of “pre-defined player-selectable pay lines” in combination with Marks’ wagering game, but Marks actually teaches away from the concept of using pay lines, as required by all claims in the pending application. Such evidence of teaching away constitutes potent evidence of nonobviousness. *In re Bell*, 991 F.2d 781, 26 USPQ2d 1529

(Fed. Cir. 1993); *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 6 USPQ2d 1601 (Fed. Cir. 1988); *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986).

In developing this prior art rejection, Marks **must** be considered in its entirety, including portions that would lead one skilled in the art away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, *supra*. With this clear statement of the law in mind, the following sequence of statements in Marks must be considered.

1. Marks describes how prior art wagering games provide awards to players – through predetermined symbol combinations aligned along enabled pay lines (this is the **only** time that Marks ever mentions the term “pay line.”) Marks, ¶ 4.
2. Marks describes the prior art “Bedazzled” game (which is not a wagering game) that provides game points to players in a different way -- by adjacent same symbol set arrangements on the matrix. Marks, ¶ 6.
3. Marks then describes that the problem with the “Bedazzled” game is that it is not fit for wagering and would not meet regulatory approval. Marks, ¶ 7.
4. Finally, Marks describes as the **first object of his invention** to provide awards based on “adjacent same symbol-set” arrangements. Marks, ¶ 9.

Without question, Marks’ desire for a “new” wagering game in which awards are based on “adjacent same symbol set” arrangements is an unequivocal teaching that pay lines are **not** to be used as the indicator of awards. The skilled artisan would never modify Marks’ basic teaching of his “new game” to arrive at the present invention because to do so would change Marks’ principle of operation and render Marks unsatisfactory for its intended purpose. MPEP §2143.01. In essence, Marks is teaching that his “new” wagering game should not have pay lines. Yet, the rejection in the present Office Action is suggesting to include pay lines in Marks’ new wagering game.

The pending claims are focused on more of a traditional slot machine with pre-defined pay lines so that the players are familiar with its look and feel, yet still receive the inventive aspect of replacing winning symbols in a first array to form a second array as it is claimed. See

Present Specification, Para. 35. Quite to the contrary, Marks desires a “new” wagering game with a payout mechanism that is entirely different from traditional slot machines. Appellant was able to develop a way to adapt the claimed symbol replacement feature into a slot-type game with player-selectable pre-defined pay lines. Marks, on the other hand, specifically chose an entirely different approach and attempted to closely replicate the prize-awarding feature of the Bedazzled™ game, as evidenced by Marks’ **first object of his invention**. Marks, Para. 6 & 9.

In summary, Marks teaches away from the claimed invention. As such, the *prima facie* case of obviousness has not been established at least for this reason alone.

## **II Rejections In View Of Luciano**

The rejections in view of Luciano also failed to establish a *prima facie* case of obviousness at least because a) it failed to articulate a reasoning for modifying Marks in view of Luciano, and b) Marks and Luciano appear to fail to disclose all claimed elements.

### **A. NO REASONING FOR MODIFYING MARKS IN VIEW OF LUCIANO**

The office action has failed to articulate any reasoning for modifying Marks in view of Luciano. The MPEP states that any rejection under § 103 must clearly articulate the respective reasoning:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that **"rejections on obviousness cannot be sustained with mere conclusory statements"**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d

1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

MPEP, Rev. 6, Sept. 2007, § 2142, pp. 2100-127, 2100-128 (emphasis added). Although the office action acknowledges that Marks “is silent on the issue of containing a second pay table,” it simply alleges that “Luciano provides a gaming device that teaches the use of a second pay table (col. 7, lines 20-25)<sup>1</sup>,” and, “[t]herefore it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Luciano into the art disclosed by Marks in order to provide different odds of winning rewards or prizes.” Nowhere does the office action articulate or provide support for this allegation.

Although the MPEP provides numerous “exemplary rationales” for supporting a rejection under § 103, none of these rationales were even remotely addressed by the office action. For example, some of the exemplary rationales include (a) combining prior art elements according to known methods to yield predictable results, (b) simple substitution of one known element for another to obtain predictable results ... (g) some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference to arrive at the claimed invention. MPEP, § 2143, p. 2100-128.

The Applicant respectfully submits that none of the exemplary rationales (or any other rationales) can support the modification of the system disclosed by Marks in view of the system disclosed by Luciano. For example, there is no motivation to combine Marks’ replace-and-remove game (based on adjacent symbol set arrangement as they appear anywhere in the array) with Luciano’s coordination/dexterity game to select from a plurality of different pay tables.

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<sup>1</sup> The cited portion fails to disclose anything about different pay tables, but a limited disclosure regarding different pay tables is located, for example, at col. 8, ll. 1-4.

**B. MARKS AND LUCIANO FAIL TO DISCLOSE ALL CLAIMED ELEMENTS**

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970), as cited in MPEP § 2143.03, p. 2100-142.

*Claims 4, 5, 12, 13, and 19* are directed to having a basic pay table associated with a basic wagering game and a bonus pay table associated with a bonus wagering game.

Luciano, which is specifically cited for disclosure of different pay tables, does not appear to disclose anywhere the use basic pay table and a bonus pay table. For example, Luciano discloses that different pay tables can be selected based on the gameplay, such as when a player provides input to simulate a golf shot hitting a golf ball to a particular region that is associated with a respective pay table. Luciano, col. 8, ll. 7-39. Thus, if the golf ball lands on the fairway, a first pay table will be used, while if the golf ball lands on the green, a second pay table will be used. *Id.* The first pay table and the second pay table are associated with the same “traditional game.” *Id.* Nowhere does Luciano appear to make the basic vs. bonus distinction.

*Claims 7, 8, 15, and 16* are directed to having a basic probability table and a bonus probability table. **The office action completely ignores these claim elements.** Additionally, nowhere does Luciano appears to disclose the use of different probability tables.

Thus, the Applicant respectfully submits that the claims rejected in view of Luciano are nonobvious at least for the above stated applicable reasons.

**Conclusion**

It is the Applicant's belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000263USPT.

Respectfully submitted,

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